

Appin No. 09/721,862
Amdt. Dated June 7, 2004
Reply to Office action of April 22, 2004

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REMARKS/ARGUMENTS

Claims

The Examiner rejected claims 1, 2 and 4-20. By this amendment, claims 1-2, 4-7, and 1-20 have been cancelled, claim 8 has been amended, and new claims 21-29 have been added. Therefore claims 8-14 and 21-29 are pending in the application.

Priority

The examiner withdrew the acknowledgement of applicant's foreign priority under 35 U.S.C. 119(a)-(d), which had been made on paper no. 5, until the certified foreign applications corresponding to applications PQ0559, PQ1313, PQ3457, and PQ4392 are filed. Therefore certified copies of those applications will follow with confirmation copy of this fax transmission.

Claim Objections

Claims 2 and 17 were objected to because of informalities. The objections are now moot as these claims have been cancelled by the present amendment.

Claim Rejections – 35 USC §102

Claims 1-2 and 4-20 were rejected under 35 U.S.C. 102(e) as being anticipated by Jared et al. (US 6,208,771; hereinafter "Jared").

The rejection is respectfully traversed. Independent method claim 8 has been amended to include the steps of printing invisible coded data and visible content, the visible content corresponding to the invisible coded data, substantially simultaneously. Such simultaneous printing of both invisible coded data and visible content is neither disclosed nor fairly suggested by Jared.

Jared teaches a method for decoding glyph codes, such as Xerox DataGlyphs (see, e.g., Jared at col. 1, line 26). The glyph codes mentioned in Jared are described in detail in U.S. patent 6,330,976 to Dymetman, which patent is also assigned to Xerox. Dymetman expressly teaches the advantages of printing visible and invisible markings in separate steps: "A coded substrate supplier could use various techniques to produce machine-readable markings such as those described above. The coded substrate could, for example, include invisible markings on paper ... A publisher can buy these apparently uniformly white sheets and can print visible markings on them using standard ink." (Dymetman at col. 11, lines 47-65.). Both Dymetman and Jared thus extol the advantages of using pre-printed coded

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substrates that can then be sent through standard printers. That teaches away from the advantages and convenience of the present invention, as defined in amended claim 8, where invisible coded data and visible content such as text and graphics are printed substantially simultaneously by a single printer.

Support for the present amendments to claim 8 is found, among other places, in U.S. Pat. No. 6,457,883, incorporated by reference into the present application, at col. 16, lines 27-32:

“The netpage wallprinter incorporates 168960 printing elements 300 to form a 1600 dpi pagewidth duplex printer. This printer simultaneously prints cyan, magenta, yellow, black, and infrared inks as well as paper conditioner and ink fixative.” The infrared inks are used to print the invisible coded data and the cyan, magenta, yellow and black inks are used to print the visible color content. Further support for the amendments is found in the present specification as filed at page 5, lines 16-20: “In its preferred form, the netpage system relies on the production of, and human interaction with, netpages. These are pages of text, graphics and images printed on ordinary paper, but which work like interactive web pages. Information is encoded on each page using ink which is substantially invisible to the unaided human eye. The ink, however, and thereby the coded data, can be sensed by an optically imaging pen and transmitted to the netpage system.”

New claims 21-29 also include limitations that are novel and nonobvious over Jared. These claims are directed to a specific type of coded data that is very different from the simple “glyphs” disclosed in Jared. Figure 4a of the present application illustrates one specific embodiment of a circular coded tag as defined in new claims 21-29. These sophisticated tags are clearly very different from the “glyphs” of Jared that comprise simple forward slashes and back slashes as shown in Figure 1 of Jared. Further support for new claims 21-29 is found in the present specification as filed at page 9, lines 22-33, in the paragraph beginning “One embodiment of the physical representation of the tag, shown in Figure 4a...”.

Amended method claim 8 and new method claims 21-29 include limitations that further define the steps of the present invention for coding a region such as a netpage using both invisible and visible data. The claimed limitations are not disclosed or suggested in any of the prior art references cited by the Examiner. Accordingly, it is submitted that the application is now in condition for allowance. Reconsideration and allowance of the application is courteously solicited.

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Very respectfully,

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